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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/894,519	06/28/2001	Attila Narin	MSFT-0259/158415.2	5975

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EXAMINER

MCCLELLAN, JAMES S

ART UNIT	PAPER NUMBER
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3627

DATE MAILED: 08/20/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/894,519

Applicant(s)

NARIN ET AL.

Examiner

James S McClellan

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 07 May 2004.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 25-35 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-17 and 25-35 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 28 June 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 10/3/01.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____.

DETAILED ACTION

Amendment

1. Applicant's submittal of an amendment was entered on May 7, 2004, wherein:
claims 1-17 and 25-35 are pending and
claims 18-24 have been canceled.

Election/Restrictions

2. Applicant's election without traverse of Group I (claims 1-17 and 25-35) in the reply filed on May 7 is acknowledged. It is noted that Applicant canceled all non-elected claims (claims 18-24).

Claim Rejections - 35 USC § 101

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.
4. Claim 17 is rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter. Claim 17 is non-statutory because it is hybrid claim that is drawn to more than one statutory type of invention. In this case, the parent claim (claim 1) is a process claim (method) and dependent claim 17 is an apparatus (a computer readable medium). Each claim should be directed to a single type of invention. Clarification is required.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-3, 7-17, 25-33, and 35 are rejected under 35 U.S.C. 102(e) as being anticipated by U.S. Patent No. 6,331,865 (hereinafter “Sachs”).

Regarding **claim 1**, Sachs discloses a method for facilitating the purchase and viewing of electronic content comprising: storing, on a first computing device(20) located at a network address, a list of web sites (via directory 26) which distribute digital content items; and providing a set of computer-executable instructions to a plurality of second computing devices (10, 12, 14; see Figure 1), said set of computer-executable instructions including instructions to perform acts comprising: rendering said digital content items (see ABSTRACT, lines 7-9, “rendering the requested digital content”); and retrieving said list from said first computing device (see column 2, lines 59-65); **[claims 2 and 9]** providing data indicative of said network address to said plurality of second computing devices (communication via ISP 34; see Figure 1); **[claim 3]** digital content is text (see column 1, line 38); **[claim 7]** storing a URL for each web site (it is inherent that URL’s will be stored for accessing websites), one or more items of text (see column 1, line 38); and a graphical image (see column 1, line 38); **[claim 8]** limiting the set of web sites on said list (see column 11, lines 20-44; additionally the list is inherently limited by the amount of memory on the device); **[claim 10]** providing computer-executable instructions which contact

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said one of said web sites (via ISP 34); **[claim 11]** browsing web pages on a computer network (see column 8, lines 65-67); providing a user interface which integrates said rendering, retrieving, and browsing acts (via display screen 230); and **[claim 12]** using a stand-alone web-browsing program for retrieving (see column 8, lines 65-67).

Regarding **claim 13**, Sachs discloses a method of supporting electronic commerce comprising: storing a directory of web sites (26); receiving a request from a computing device to add a one of said web sites to a list stored on said computing device (when the owner of the computing device initially activates service, the owner inherently requests the addition of web sites to a list on the device via directory 26); and uploading data indicative of said one of said web sites to said computing device for storage in a registry on said computing device (the data is stored in directory 26 on system 20, but the data is accessed via a graphical user interface on the computing device 10, wherein the computing device 10 inherently includes some data indicative of said one of said web sites); **[claim 14]** distributes digital content (see column 1, lines 37-41); **[claim 15]** the directory includes HTML file (see column 6, lines 6); **[claim 16]** downloading an HTML file for viewing with a browser (inherent) and said browser renders clickable buttons (see Figure 2); and **[claim 17]** a computer-readable medium having computer-executable instructions to perform the method of claim 13 (it is inherent that each computing device will have a computer-readable medium for executing the method).

Regarding **claim 25**, Sachs discloses a method of facilitating electronic commerce comprising: storing, at a first computing device (20) having a network address, data indicative of commerce sites; providing to a second computing device (10): data indicative of said network address; and a set of computer-executable instructions which: contact said first computing device

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(20) at said network address to obtain at least some of said data indicative of said commerce sites, whereby said at least some data is stored on said second computing device (10) in a predetermined location; engage in communication with a one of the commerce sites whose indicative data is stored in said predetermined location (i.e. the primary bookstore); exclude contact with sites whose indicative data is not stored on said second computing device (10) in said predetermined location (see column 11, lines 20-37); **[claim 26]** distributes digital content (see column 1, lines 37-41); **[claim 27]** engage a stand-alone web browsing program (see column 6, line 1-35); **[claim 28]** said network address comprises a URL (see column 5, line 50); and **[claim 29]** said commerce sites includes a URL (see column 5, line 50 and column 7, lines 22).

Regarding **claim 30**, Sachs discloses a method of purchasing digital content comprising: starting a content rendering program (see column 2, lines 35-38) on a first computing device (10), said first computing device (10) storing an address of a second computing device (20); obtaining from said second computing device (20) an address for a third computing device (i.e. primary bookstore); using said content rendering program to connect to said third device; and placing an order for digital content with said third computing device (see column 6, lines 1-35); **[claim 31]** storing the address of said third computing device on said first computing device (via directory 26); **[claim 32]** placing an order for text (see column 1, lines 35-38); **[claim 33]** obtaining from said second computing device (20) a description of a web site hosted by said third computing device (i.e. primary or secondary bookstore); and **[claim 35]** obtaining a URL (see column 5, line 50 and column 7, lines 22).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 4-6 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of U.S. Patent No. 6,324,288 (hereinafter "Hoffman").

Sachs fails to explicitly disclose digital content comprising audio, video, or software for download.

Hoffman teaches the use of digital content including audio, video, and software (see column 3, lines 35-37).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sachs with the distribution of audio, video, and software digital content as taught by Hoffman, because distributing a wider selection of content will increase the size and potential revenue earned by the distributor.

9. Claim 34 is rejected under 35 U.S.C. 103(a) as being unpatentable over Sachs in view of Official Notice.

Sachs fails to explicitly disclose associating a logo with a web site.

The Examiner takes Official Notice that it was old and well known at the time the invention was made to attach logo to web site links.

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It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Sachs with logos as is well known in the art, because logos give a visual representation of the web site, wherein building or reinforcing the web site's brand.

Conclusion

10. The prior art made of record and not relied upon is considered pertinent to Applicant's disclosure.

Flake et al. is cited of interest for disclosing an automated travel service management information system.

Duga et al. is cited of interest for disclosing an on-line menu updating for an electronic book.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jim McClellan whose telephone number is (703) 305-0212. The examiner can normally be reached on Monday-Friday from 9:30 to 6:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Olszewski, can be reached at (703) 308-5183.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-1113.

Any response to this action should be mailed to:

Commissioner of Patent and Trademarks
Washington D.C. 20231

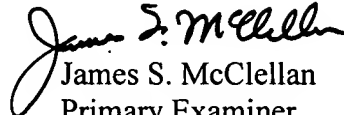
or faxed to:

(703) 872-9306 (Official communications) or

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(703) 746-3516 (Informal/Draft communications).

Hand delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th floor receptionist.


James S. McClellan
Primary Examiner
A.U. 3627

jsm
August 17, 2004